

PATENT

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APPELANTS: P. Dubbert et al.

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EXAMINER: Chin Shue, Alvin C.

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APPEAL REPLY BRIEF (37 CFR 41.41)

This reply brief is in response to the Examiner's Answer filed in this case on April 10, 2009.

This brief contains these items under the following headings and in the order set forth below (37 CFR 41.37 and MPEP 1208):

- I. STATUS OF CLAIMS
- II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- III. ARGUMENT: REJECTIONS UNDER 35 U.S.C. §103

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June 8, 2009
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I. STATUS OF CLAIMS (37 CFR 41.37 (c)(1)(iii))

The status of the claims in this application are as follows:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: **21**

B. STATUS OF ALL THE CLAIMS

(If there are no claims in a category indicated: NONE)

1. Claims cancelled: **7 and 13-15**
2. Claims withdrawn from consideration but not cancelled: **1-6, 8-12, and 19-21**
3. Claims pending: **1-6, 8-12, and 16-21**
4. Claims allowed: **None**
5. Claims rejected: **16-18**

C. CLAIMS ON APPEAL

The claims on appeal are: **16-18**

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 CFR 41.37 (c)(1)(vi))

The following grounds of rejection are requested to be reviewed on appeal:

A. The Examiner's conclusion that Claims 16-18 are obvious under 35 U.S.C. §103 over U.S. Pat. No. 4,850,453 issued to *St-Germain* (hereafter referred to as "*St-Germain*") in view of U.S. Pat. No. 3,690,613 issued to *Shoemaker* (hereafter referred to as "*Shoemaker*"), and U.S. Pat. No. 3,741,516 issued to *Rugger* (hereafter referred to as "*Rugger*").

B. The Examiner's restriction of Claims 1-6, 8-12 and 19-21.

III. ARGUMENTS - REJECTIONS UNDER 35 U.S.C. § 103 (CFR 1.192(c)(8)(iv))

A. Introduction and Overview

The Examiner rejected Claims 16-18 under 35 U.S.C. §103(a) as being unpatentable over *St-Germain* in view of *Shoemaker* and *Rugger*. On July 18, 2008 Applicants filed their Appeal Brief, wherein Applicants respectfully disagreed with the Examiner's conclusion. In the Appeal Brief, Applicants asserted that the references cited by the Examiner fail to disclose all of the elements of the claims, in accordance with the requirements of the MPEP, and hence, the references cannot make the claims obvious. In addition, Applicants asserted that the Examiner failed to make a prima facie showing of obviousness or otherwise improperly interpreted or applied the disclosure of the cited patents.

On April 10, 2009, the Examiner filed an Examiner's Answer, which reiterates the rejection of Claims 16-18 as being unpatentable over *St-Germain* in view of *Shoemaker* and *Rugger*. The Examiner's Answer disagrees with the Appeal Brief's contentions that none of the references teach or disclose a flexible attachment strap or a standoff in claim 16. Furthermore, the Examiner's Answer disagrees with the Appeal Brief's contentions that the cited references do not contain any suggestion to combine the elements, that the references teach away from the combination, render the references inoperable and would change the principle of operation.

However, the Examiner's Answer misunderstands or mischaracterizes the cited references and makes numerous misstatements regarding Applicant's arguments in support of patentability of the claims. Ultimately, the Examiner's determination that Claims 16-18 are obviousness in light of the cited references has no basis.

Therefore, Appellant reaffirms the arguments made in Appellant's Brief, filed September 28, 2006 and, herein, responds to the mischaracterizations and misstatements in Examiner's Answer.

B. The Examiner's Answer Mischaracterizes the Cited References and Misstates Applicant's Appeal Brief.

In the Answer the Examiner reiterates his assertion that *St-Germain* shows a standoff bracket (Fig. 1; 5-9), a standoff leg (10), and a dowel (23), as well as his admission that *St-Germain* does not disclose an attachment strap or a retainer body. (Answer, pp. 3-4). The Examiner also reiterates his assertion that *Shoemaker* teaches an attachment strap (Fig. 1; 34) with an eyelet (22), a retainer body (20) with slotted walls (78), and a wedge (22). *Id.* Furthermore, the Examiner again cites *Rugger* as showing an attachment strap made from a flexible material. *Id.*

In support of these assertions, the Examiner contends that the tie rod (34) disclosed in *Shoemaker* is equivalent to a flexible strap because it has "somewhat flexible tie rod ends". Applicant recognizes that during examination a claim must be given its broadest reasonable interpretation, but the interpretation must be consistent with the specification. MPEP 2111; *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ 1321 (Fed. Cir. 2005). The interpretation of the claim must also be consistent with the interpretation that would be reached by those of ordinary skill in the art. *Id.*; also *In re Cortwright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464 (Fed. Cir. 1999). It is inconceivable that one of ordinary skill would describe a metal leaf spring strip in conjunction with a rigid tie rod as a "flexible strap", even if the ends are "somewhat flexible". Such a broad interpretation is not within the plain meaning of "flexible strap", is not consistent

with the use of the term within the specification, and is not reasonable. One of ordinary skill in the art would understand a “flexible strap” to be flexible along its length, not merely at its ends.

Not only does the Examiner’s Answer ignore the plain meaning of the terms “tie rod” and “flexible strap” and the use of those terms within the Applicant’s specification, the Examiner’s Answer ignores the defined function of the tie rod (34) as disclosed in *Shoemaker*. As previously noted in the Appeal Brief, *Shoemaker* teaches that a rigid tie rod is required to handle compression forces, stating, “the tie rod must be strong enough to assimilate the large stresses which are imposed upon it during pouring of wet concrete into the space between the spaced apart sides of the associated concrete wall form.”(*Shoemaker*, 1:47-51). Therefore, the Examiner’s contention that the tie rod (34) disclosed in *Shoemaker* is equivalent to a flexible strap is incorrect.

The Examiner also misstates Applicant’s arguments regarding *Rugger*. For instance, nowhere in the Appeal Brief do Applicants assert that *Rugger* discloses a rigid tie strap. In direct contrast, the Appeal Brief expressly acknowledges that *Rugger* discloses a “bendable tie strap (14)”. (Appeal Brief, p. 7). In further contrast, the Appeal Brief states that, “*Rugger* discloses another concrete form securing means comprising a rigid tie rod (9) extending between a pair of forms and secured by a wedge members (6) and heads (10). (*Rugger* 2:40-66).”(Emphasis added). *Id.*

The Examiner’s misstatement of Applicant’s arguments complements his misunderstanding of *Rugger*, which contends that the bendable tie strap shows “tie straps made of a flexible material is conventional in the art”. (Answer p.6) This completely disregards the principle of operation of the *Rugger* tie strap (14). The bendable tie strap (14) does not operate independently, but rather, in conjunction with the rigid tie rod (9) and wedge members (6) to

hold the form parts in a fixed relation relative to each other to support compressive forces. (*Rugger* 3:44-47, 54-58). As discussed in more detail in the Appeal Brief, “The tie rods and the tie strap (14) in conjunction with the wedge hold the plywood panels in predetermined fixed relation ready to receive concrete.” (Appeal Brief, p. 7). Nothing in the prior art references discloses or suggest the use of the bendable tie strap (14) independently.

Furthermore, the Examiner’s rebuttal to Applicant’s contention that the cited references teach away from the suggested combination, and that such combination would change the principle of operation and render the references inoperable, is based on faulty grounds. The Examiner’s position appears to be based on his erroneous determination that a *prima facie* rejection under 35 U.S.C. §103 only requires that “Shoemaker is CAPABLE of being used with the dowel of *St. Germain* so that his scaffolding is CAPABLE of being secured to a wall as DISCLOSED by Appellant’s invention.”(Answer p.5). Likewise, the Examiner erroneously contends that Claims 16-18 include limitations that the flexible attachment strap and retainer are “capable of” being attached to the bracket.

However, Claims 16-18 do not recite the functional limitation “capable of”. Rather, Claim 16 includes the structural limitation, “a flexible attachment strap having a first end...said first end sized and shaped to fit over said standoff assembly attachment dowel”(Emphasis added). Therefore, the Examiner’s analysis under 35 U.S.C. §103 is improper. Furthermore, the cited references do not disclose the structural limitations of Claim 16.

The Examiner’s §103 analysis also improperly compares the cited references to the device “as DISCLOSED by Appellant’s invention.” (Answer p.5). Under MPEP 2141 and *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), a proper §103 analysis requires the Examiner to ascertain the differences between the claimed invention and the prior art, not

between the disclosure and the prior art. By comparing the cited references to the Applicant's disclosure, the Examiner imported limitations that are not part of the claim, which is clearly improper. MPEP 2111.1.

Apart from the foregoing flaws in Examiner's arguments, *St. Germain* simply can not be combined with *Shoemaker* because the claimed strap 34 of *Shoemaker* would serve no purpose in when combined with *St. Germain*. The bracket element (12) of *St. Germain* is "rigidly, permanently secured to the inner wall 16" with screws (15). (*St. Germain* 3:6-34). Therefore, there is no need for the attachment strap of *Shoemaker* to fit over the dowel of *St. Germain* and secure the scaffolding to the wall as contended by the Examiner. Because of this, one would could not reasonably expect one of ordinary skill in the art to modify *St. Germain* to include a flexible attachment strap. Further, because *St. Germain* discloses permanently securing the bracket element to the wall, *St. Germain* teaches away from Applicant's claimed invention.

Accordingly, Applicants respectfully submit that Claims 16-18 are allowable over *St-Germain*, *Shoemaker*, and *Rugger* whether considered individually or in combination. Applicants thus request that the Examiner's rejection of Claims 16-18 be reversed.

C. The Examiner May Not Rely On Inherency To Supply A Missing Element.

For the first time in the prosecution of the application at issue, the Examiner asserts an inherency argument in support of his rejection of Claim 18. More specifically, the Examiner contends that correspondingly sloping the slot and wedge, "inherently would provide an enlarged sliding surface that would facilitate insertion."(Examiner's Answer, p. 6). In the Appeal Brief, Applicant asserted that the Examiner failed to provide any evidentiary support for his assertion that it would have been an "obvious engineering design expediency" to slope the surface of the slots to correspond to the slope of the wedge. The Examiner's apparent abandonment of this

previous argument and his adoption of the inherency argument is an implicit admission that none of the cited references disclose the limitations of Claim 18.

Furthermore, the Examiner's reliance on "inherency" to support the rejection of claim 18 confuses anticipation, or lack of novelty by inherency, with obviousness. Anticipation and obviousness are separate and distinct concepts. *Jones v. Hardy*, 220 USPQ 1021, 1025 (Fed. Cir. 1984) citing *In re Pearson*, 181 U.S.P.Q. 641 (CCPA 1974); *In re Oelrich*, 666 F.2d 578,212 USPQ 323 (CCPA 1981). "[T]he inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann and Heinke*, 150 USPQ 449, 452 (CCPA 1966). Accordingly, it is not appropriate to rely on inherency to supply a missing element. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578,581 (CCPA 1981) quoting *Hansgrig v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1938); MPEP 2112. "Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948, F.2d. 1264 (Fed. Cir. 1991).

Therefore, Claim 18 is allowable over *St-Germain*, *Shoemaker*, and *Rugger*, whether considered individually or in combination.

G. Conclusion

As discussed above, the references fail to disclose the noted elements of the claims. In particular, the references do not teach or suggest "an attachment assembly for securing an upright of a scaffolding system to a retaining wall" where the attachment system comprises (1) a standoff bracket; (2) a flexible attachment strap which extends through the wall; and (3) a

retainer which engages the attachment strap on the side of the wall opposite the stand-off to pull the stand-off against the wall. Hence, in accordance with the requirements of the MPEP, as set forth in Chapter 2100, the references cannot make the claims obvious. Further, as noted above, in particular instances, the Examiner failed to make *prima facie* showings of obviousness or otherwise improperly interpreted or applied the disclosure of the cited patents.

As discussed above, Claims 16-18 are allowable over *St-Germain*, *Shoemaker*, and *Rugger*, whether considered individually or in combination. Applicants thus respectfully request that the Board reverse the Examiner's rejections of Claims 16-18. Also, Applicants respectfully request that the Board reverse the Examiner's restriction of Claims 1-6, 8-12 and 19-21.

Respectfully submitted,

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